

### **REMARKS**

The Office Action mailed on September 30, 2009 (the "Office Action") rejected claims 1-3, 6-12, 14-18, 20-24, and 27-29.

With entry of this Amendment and Response claims 25-27 have been renumbered as 27-29 and claims 6-8 and 14 are now amended. The Applicants submit that no new matter is introduced by the amendments and support for the amendments is found throughout the specification.

With entry of this Amendment and Response claims 1-3, 6-12, 14-18, 20-24, and 27-29 will be pending and under consideration.

### **Interview Summary**

Applicants' Attorney thanks the Examiner for conducting an Examiner Interview on December 23, 2009. Applicants' Attorney and the Examiner discussed the Kirmse reference and Applicants' Attorney explained that Kirmse does not automatically search for and detect games currently executing on the user's terminal nor does Kirmse have a second program which determines the connection status as recited in the previously presented claims. The Examiner's position was that these operations can be performed manually by the user and that automating these functions requires only routine skill in the art. No agreement was reached.

### **Claim Objections**

The Office Action objected to claims 25-27, stating that they should be renumbered 27-29. This is because Applicants had previously submitted claims 25 and 26, and canceled them prior to the last Office Action Response. Applicants thank the Examiner for noting this and the claim numbering has been corrected.

### **Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 6-8 and 14-17 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter. Applicants have amended claims 6-8 to be dependent from claim 1 and amended claim 14 to be dependent from claim 12. Because claim 15 depends from 14, and 14 now overcomes

the § 112 rejection in the Office Action, Applicants submit that claim 15, as previously presented, overcomes the § 112 rejection and amending it is not necessary. Claims 16 and 17 similarly depend indirectly from claim 14 and therefore also require no amendment. Applicants therefore respectfully request withdrawal of the § 112 rejection.

**Rejections Under 35 U.S.C. § 102(b) and § 103(a)**

Claims 1-3, 6-12, 14-18, 20-24, and 27-29 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Publication No. 2002/0086732 to Kirmse ("Kirmse") of record or, in the alternative, under 35 U.S.C. § 103(a) as allegedly being obvious over Kirmse.

Applicants believe, based on the Examiner Interview held after the Office Action was mailed, that the Examiner understands and agrees that Kirmse does not anticipate the claims. Specifically, Applicants submit that Kirmse does not automatically search for and detect games currently executing on the user's terminal - instead relying on a game's incorporation of an SDK code to determine which games are running - nor does Kirmse have a second program which determines the connection status as recited in the previously presented claims (as noted in the *Office Action*, pg. 6-7). Applicants believe the Examiner, however, maintains the rejection in the Office Action under § 103, that:

...it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a program when one is not provided to facilitate logging in to a game server, since it has been held broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art.

*Office Action*, pg. 6. Applicants respectfully submit that the reasoning in the Office Action is inapplicable and the claimed invention, as a whole, goes beyond mere automation.

A. The Case Law Cited In The Office Action Is Not Sufficiently Similar To Warrant Its Application

The MPEP states that “legal precedent can provide the rationale supporting obviousness only if the facts in the case are sufficiently similar to those in the application.” MPEP § 2144 (III) (emphasis added). The case cited in the Office Action, *In re Venner*, 262 F.2d 91, 95 (CCPA 1958), involves an invention that combined “old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed.” MPEP § 2144.04 (III). It does not have facts similar to the instant application’s claims – there is no client program that automatically detects when selected individuals are playing one or more multiplayer games on a computer network, no client program that notifies a user of the games on the network or selected individuals playing the games, nor any of the other limitations of the present claims. Without *any* factual similarities, the MPEP instructs that *Venner* cannot be applied to the instant case. Therefore Applicants respectfully submit that the claims are not obvious in light of the prior art based on this reasoning and request withdrawal of the rejection under § 103.

B. The Claimed Invention As A Whole Is Not Mere Automation Of Known Steps.

“In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP § 2141.02, quoting *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, (Fed. Cir. 1983) (emphasis in original). The Office Action seems to supplement what is not found in Kirmse by saying that the missing elements themselves would have been obvious to implement using routine skill. *Office Action*, pg. 6-7. This is not the correct analysis.

The claims recite a system where the user’s client searches for and detects games running on the user’s terminal and where the user’s friends’ computers report, across a network, what games the friends are playing (but without the requirement of incorporating an SDK into the game). The claims *as a whole* are not achievable by mere automatic steps that a user could take. The user cannot determine what is executing on the friends’ computers without standing over their friends’ shoulders.

Similarly, the claims also recite searching for and detecting when one or more of the games are executing on the user's terminal. This is not mere automation because a user may not know which executing processes are games and which are not. In Kirmse, the user does not need to know because the game informs the client that it is a game if it has incorporated the code to do so. In the present application though, the games do not communicate with the client. Instead, the client program searches for and detects which processes are games and which are not. This is not taught by Kirmse and is not merely an automation of steps the user can perform.

Therefore, Applicants respectfully submit that the claims are not anticipated, are not obvious, and are allowable over the prior art and request the withdrawal of the rejection under § 103.

Claim 6 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kirmse of record and in view of U.S. Publication No. 2004/0032876 to Garg ("Garg") of record. For the reasons above, claim 1 is allowable. Garg does not supply the elements missing from the Kirmse reference – namely at least searching for and detecting games executing on the user's terminal – to make claim 1 invalid, and because claim 6 depends from an allowable base claim, it too is allowable. Therefore, Applicants respectfully request withdrawal of the rejection of claim 6 under § 103.

### **CONCLUSION**

Applicants' discussion of particular positions of the Office Action or the Examiner does not constitute a concession with respect to any positions that are not expressly contested by the Applicant. Applicants' emphasis of particular reasons why the claims are patentable does not imply that there are not other sufficient reasons why the claims are patentable nor does it imply the claims were not allowable in their unamended form.

Applicants requests that the Examiner reconsider the application and claims in light of the foregoing amendment and response, and respectfully submit that the claims are in condition for allowance. If the Examiner believes that a telephone conversation with Applicants' Attorney would expedite allowance of this application, the Examiner is cordially invited to call the undersigned attorney.

Respectfully submitted,

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